



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,294	01/23/2002	Robert Roosevelt Silverman		5817

7590 02/14/2006  
Robert R. Silverman  
M313  
655 S. FAIROAKS AVE  
Sunnyvale, CA 94086

EXAMINER

VIG, NARESH

ART UNIT PAPER NUMBER

3629

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/053,294

**Applicant(s)**SILVERMAN, ROBERT  
ROOSEVELT**Examiner**

Naresh Vig

**Art Unit**

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-4 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claim 1, drawn to:

A system to enforce a Protection of Private Property in Public Systems

Using Smart Card comprising of a system of:

- Memory Smart Card (MSC) and
- Instrumented Machine instrumented with:
  - Card Acceptance Device,
  - Logic Decision Circuit, capability consists of operations
    - generation of session key,
    - comparison of two keys,
    - lock door,
    - unlock door.
  - Small Persistent Memory, and
  - Electronically lockable door

classified in class 705, subclass 1.

II. Claims 2 and 3, drawn to:

A system to enforce a Protection of Private Property in Public Systems Using Smart Card comprising of a system of:

- Memory Smart Card (MSC) and
- Instrumented Machine instrumented with:
  - Card Acceptance Device,
  - Microprocessor Based System (MBS), consists of operations:
    - generation of session key,
    - comparison of two keys,
    - lock door,
    - unlock door.
  - Small Persistent Memory, and
  - Electronically lockable door.

The MBS can be programmed in any of the following languages.

It can be programmed in machine language, assembly, or any high level language (currently known or developed in the future) and compiled into executable code, OR, a Java Virtual Machine for smart cards) or Java Micro Edition.

classified in class 705, subclass 1.

III. Claim 4 drawn to:

A system to enforce a Protection of Private Property in Public Systems Using Smart Card comprising of a system of:

- Microprocessor Smart Card (CSC) capability consists of operations
  - generation of session key,
  - comparison
- Instrumented Machine instrumented with
  - Card Acceptance Device,
  - Logic Decision Circuit, consists of operations:
    - lock door,
    - unlock door.
  - Small Persistent Memory, and
  - Electronically lockable door.

The CSC runs KVM (a Java Virtual Machine for smart cards) and executes a smart card application in Java byte codes

classified in class 705, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

In Invention I, Logic Decision Circuit generates session key, compares two keys, locks door, unlocks door.

In Invention II, Microprocessor Based System generates session key, compares two keys, locks door and unlocks door. Examiner has noted that claims 2 and 3 are similar except for the programming language. Should the applicant think that the programming language changes the scope of invention, then applicant is requested to

Art Unit: 3629

elect either of claim 2 or claim 3 should the applicant elects Invention II as their invention.

In Invention III, Microprocessor Smart Card generates session key, compares two keys, and, Logic Decision Circuit locks door and unlocks door.

Because these inventions are distinct for the reasons given above and the search required for one Group is not required for the other Groups, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents

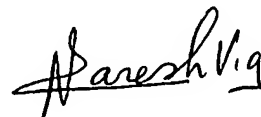
Art Unit: 3629

located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Naresh Vig', with a stylized flourish at the end.

Naresh Vig  
Examiner  
Art Unit 3629

February 9, 2006